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Paper No. 32

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MAILED

SEP 17 2012

OFFICE OF PETITIONS

In re Patent No. 6,722,108 :
Issued: April 20, 2004 : ON PETITION
Application No. 09/338,158 :
Filed: June 22, 1999 :
For: COUPON INSERTING APPARATUS :

This is in response to the petition under 37 CFR 1.378(c), filed May 29, 2012, and the supplemental petition under 37 CFR 1.378(c), filed September 6, 2012, to accept the unintentionally delayed payment of the second maintenance fee for the above-identified patent.

The patent issued on April 20, 2004. The grace period for paying the second maintenance fee expired on April 21, 2012. These petitions are filed timely under the provisions of 37 CFR 1.378(c) because they were submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e).

On May 29, 2012, a petition under 37 CFR 1.378(c) was filed and properly signed by the assignee, C. Joyce Witt. The petition included a certification that C. Joyce Witt was empowered to act on behalf of the assignee of the entire interest, as well as identified the reel and frame number where the assignment was recorded. However, the Office could not process the credit card authorization form for payment of the required maintenance fee and surcharge because the credit card was declined.

On September 6, 2012, a second petition under 37 CFR 1.378(c) was filed and signed by Anthony J. Nowakowski. The petition was

accompanied by the payment of the second maintenance fee and the surcharge for late payment due to unintentional delay.

Pursuant to 37 CFR 1.378(d), "Any petition under [37 CFR 1.378] must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest." A person or organization whose only responsibility as to the patent is the payment of the maintenance fee is not a party in interest for purposes of 37 CFR 1.378. See MPEP 2590. If a person not registered to practice before the Office signs the petition, the petition must indicate that the person signing the petition is the patentee, assignee, or other party in interest. Id. An assignee must comply with the requirements of 37 CFR 3.73(b). Id.; See MPEP 324.

In this instance, there is no indication in the USPTO's records that Mr. Nowakowski is an attorney or agent registered to practice before the USPTO. Moreover, Mr. Nowakowski has not shown that he has authority to sign on behalf of an assignee. Specifically, neither the present petition nor the patent file include a Statement under 37 CFR 3.73(b) authorizing Mr. Nowakowski to act on behalf of an assignee.¹ The Office will not

¹ Pursuant to 37 CFR 3.73:

(b) (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

- (i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment)...For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or
- (ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

presume from the filing of the petition and payment of the requisite fees that Mr. Nowakowski is a proper party pursuant to 37 CFR 1.378(d). See generally MPEP 324 and 37 CFR 3.73(b). It is concluded that the petition submitted by Mr. Nowakowski is improperly signed, and therefore, will not be treated on the merits. Accordingly, the petition is dismissed.

In order for Mr. Nowakowski to take action in this matter, Mr. Nowakowski must establish that he is a registered patent practitioner, the patentee, assignee, or other party in interest. If Mr. Nowakowski is acting on behalf of the assignee, he must submit a completed Statement Under 37 CFR 3.73(b). Additionally, Mr. Nowakowski must file a "renewed" petition under 37 CFR 1.378(c). No additional fees are required. The appropriate forms are enclosed for Mr. Nowakowski's convenience.

Lastly, the address listed on the petition differs from the correspondence address of record. As a one-time courtesy, the Office will mail a copy of this decision to the address indicated on the petition. However, until otherwise instructed, the Office will mail all future correspondence regarding this patent solely to the address of record. Petitioner may wish to file a change of correspondence address with the USPTO.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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- (2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:
- (i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or
 - (ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

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By fax: (571) 273-8300
ATTN: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Correspondence may also be submitted electronically via the USPTO electronic filing system.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Forms PTO/SB/66; PTO/SB/96; PTO/SB/123

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